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400 Garden City Plaza  
Garden City, NY 11530

EXAMINER
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DOAN, DUYEN MY

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2152

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PAPER

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

**MAILED**

**AUG 16 2007**

**Technology Center 2100**

Application Number: 10/081,941  
Filing Date: February 22, 2002  
Appellant(s): HENDRIKS ET AL.

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Steven Fischman  
For Appellant

**EXAMINER'S ANSWER**

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This is in response to the appeal brief filed 3/09/2007 appealing from the Office action mailed 10/12/2206.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,564,249	Shiigi	10-2001
2002/0143994	Sun et al	03-2001
6,779,178	Lloyd	9-1999

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-13,18,19-30,35-47,52-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiigi (us pat 6,564,249) in view of Sun et al (us 2002/0143994).

As regarding claim 1, Shiigi discloses establishing by at least some of the network of computers a connection to said instant messaging system (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67; col.4, lines 1-49, plurality of client computers adapted for handwriting input are used by users); providing to a plurality of users by said instant messaging system a graphical user interface comprising a recording field (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67, each user enter handwritten message through a graphical interface); displaying in said recording field for viewing by said users a chat record comprising one or more instant messages from a currently ongoing instant messaging session (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67, each user enter handwritten message through a graphical interface, also see figure 2b); directly inputting handwritten stroke information message objects anywhere within said recording field to thereby annotate said one more instant text messages in said chat record (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67, each user enter handwritten message through a graphical interface); distributing by said instant messaging system said annotated one or more instant text messages for viewing by said plurality of users in said recording field (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67; col.4, lines 1-49, plurality of client computers adapted for handwriting input are used by users).

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Shiigi discloses the handwritten messages are enter by client through a graphical interface in an email system to send email messages to other clients. Shiigi does not explicitly disclose chat messages or chat record.

Sun teaches communicating the handwritten messages in a chat system (see Sun pg.1, par 7).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teaching of Sun to the method of Shiigi because both Shiigi and Sun's inventions are concern with inputting handwritten message in an instant messaging system for the purpose of to communicate handwritten message in a chat system because by using the chat system to send handwritten messages would allow clients in the network instantly send and receive messages (see Sun pg.1 par 0006).

As regarding claim 2, Shiigi-Sun discloses wherein said message objects are IM objects (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67).

As regarding claim 3, copying a plurality of messages from other application (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67).

As regarding claim 4, messaging system is of a peer-to-peer type (see Sun pg.1, par 3). Peer-to-peer chat system is conventional technique to connect clients in the chat system.

As regarding claim 5, Shiigi-Sun discloses forwarding said handwritten stroke information to at least one participant (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67).

As regarding claim 6, Shiigi-Sun discloses wherein said messaging system updates chat record of all said current messages for distribution to, and handwritten stroke information annotation by users of said messaging system, said method further comprising appending said handwritten stroke information onto said chat record (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67).

As regarding claim 7, Shiigi-Sun discloses wherein said establishing said connection is initiated by a first of a plurality of said users of said messaging system (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67).

As regarding claim 8, Shiigi-Sun discloses said graphical user interface comprises a handwritten stroke input field (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67).

As regarding claim 9, Shiigi-Sun discloses wherein said graphical user interface comprises an awareness field (see Sun pg.3, par 25-27). The same motivation was utilized in claim 1 applied equally well to claim 9.

As regarding claim 10, Shiigi-Sun discloses wherein said graphical user interface comprises a text input field (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67).

As regarding claim 11, entering text into said text input field wherein said text is associated with said message objects for transmission to said messaging system (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67).

As regarding claim 12, Shiigi-Sun disclosed entering handwritten stroke information into said handwritten stroke input field wherein said handwritten stroke

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information is associated with said message objects for transmission to said messaging system (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67).

As regarding claim 13, Sun-Becker disclosed logging and displaying a complete history of said current messages in said recording field of said graphical user interface (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67).

As regarding claim 18, Shiigi-Sun discloses searching said recording field based on user-selected criteria (see Shiigi col.2, lines 21-67).

As regarding claims 19-30 the limitations are similar to claims 1-13, therefore rejected for the same rationale as claims 1-13.

As regarding claim 35 the limitations are similar to claim 18, therefore rejected for the same rationale as claims 18.

As regarding claims 36-47 the limitations are similar to claims 1-13, therefore rejected for the same rationale as claims 1-13.

As regarding claim 52 the limitations are similar to claim 18, therefore rejected for the same rationale as claims 18.

As regarding claim 53-55, the limitations are similar to claim 1-13, , therefore rejected for the same rationale as claim 1-13.

Claims 14-17, 31-34, 48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiigi and Sun as applied to claim 1 above, and further in view of Lloyd et al us pat 6779178 (hereinafter Lloyd).



As regarding claim 14, Shiigi and Sun disclosed all the limitation of claim 1 above, but fail to disclose URL for providing location information of an associated said message objects in said record.

Lloyd teaches URL for providing location information of an associated said message objects in said recording field (col.22, lines 34-46).

It is obvious to one with ordinary skill in the art at the time of the invention was made to combine the teaching of Lloyd with the method of Sun-Becker to have messages contain URL for providing information location for the purpose of when the text is displayed with a URL in the status bar, user viewing the message could go to the URL by clicking on the link (see Lloyd col.22, lines 43-46).

As regarding claim 15, Shiigi-Sun-Lloyd disclosed each of said plurality of users may navigate through said recording field to said associated said message objects by selecting said at least one URL whereby said associated said message objects are displayed to said plurality of users (see Lloyd col.22, lines 43-46). The same motivation was utilized in claim 14 applied equally well to claim 15.

As regarding claim 16, Shiigi-Sun-Lloyd disclosed annotating in said instant text messages in said recording field by any of said plurality of users; and using said hyperlink for alerting said plurality of users of said annotation (see Lloyd col.22, lines 43-46, HTML tag to create a link). The same motivation was utilized in claim 14, applied equally well to claim 16.

As regarding claim 17, Shiigi-Sun-Lloyd disclosed a) navigating to a desired said message object in said recording field (see Sun pg.3, paragraph 25-27); b) selecting the

desired said message to be annotated (see Sun pg.3, paragraph 25-27); and c) adding new handwritten stroke information message objects to said recording field (see Sun pg.3, paragraph 25-27).

As regarding claims 31-34 the limitations are similar to claims 14-17, therefore rejected for the same rationale as claims 14-17.

As regarding claims 48-51 the limitations are similar to claims 14-17, therefore rejected for the same rationale as claims 14-17.

#### **(10) Response to Argument**

In response appellant's argument that the prior art does not teach "a chat record comprising one message from a currently ongoing instant text messaging session" Shiigi teaches an email messaging system having a capability of allowing the client inputting handwritten message through an graphical interface and the email system will send the handwritten message to the intended client. The clients also have the graphical data viewing area for viewing the data (see Shiigi col.2, lines 21-36, also see figure 4 of Shiigi). Therefore, Shiigi teaches a graphical input area and this graphical input area is equivalent to the input record as claimed. The time that the user inputting the handwritten message into the graphical interface is the real time session that the user will communicate that handwritten data to other user, therefore Shiigi teaches the ongoing session. The only different is the input area in Shiigi is in an email system, not

a chat record or chat system. However in the same field, Sun discloses a chat system having the capability of inputting the handwritten message (see Sun pg.1, par 0007), and of cause the chat system inherently having a chat record for inputting the handwritten message. By incorporating the teaching of Sun into Shiigi, a person with ordinary skill in the art would come up with the present invention and it clearly state in Sun that the advantage of using the chat system over other instant messaging system would allow the client quickly send text messages to other clients.

In response to appellant's that the prior art does not teach "directly inputting handwritten message anywhere within the recording field thereby annotate one instant message in the chat record". As discussed above, the combination of Shiigi and Sun teaches a graphical interface or a record for inputting handwritten message. Specially, Shiigi teaches a graphical interface for the user inputting the handwritten message. As discussed above the graphical interface in Shiigi is equivalent to the record as claimed, and of cause the handwritten message has to directly inputting the graphical interface, otherwise, where else it will input the handwritten message. The limitation "thereby annotate one instant message in the chat record" is merely states the result of the limitation "directly inputting handwritten message" in the claim adds nothing to the patentability or substance of the claim.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that

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any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, It is clearly state In Sun that the advantages or motivation that utilizing the chat instead of the email system of Shiigi would allow the client quickly send the message to other clients.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

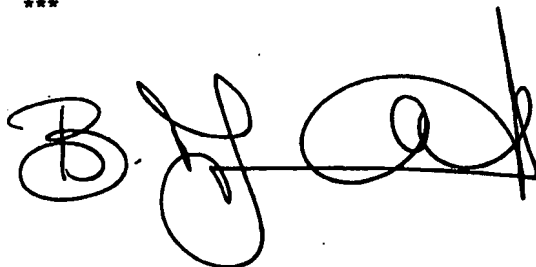
Examiner

Duyen Doan



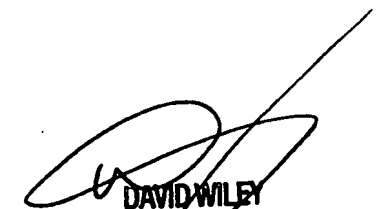
Conferees:

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